

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/196,524 11/20/98 JESSOP

P 3517.1

EXAMINER

IM22/0619

THOMAS J. ROSSA, ESQ.
HOLME, ROBERTS & OWEN LLP
111 EAST BROADWAY
SUITE 1100
SALT LAKE CITY UT 84111-5233

HANDY, D

ART UNIT

PAPER NUMBER

1743

DATE MAILED:

06/19/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/196,524

Applicant(s)
Jessop et al.

Examiner
Dwayne K. Handy

Art Unit
1743



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Apr 6, 2001

2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 2-9 is/are pending in the application

4a) Of the above, claim(s) _____ is/are withdrawn from consideration

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 2-9 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirements

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other:

Art Unit: 1743

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 2-4 and 6-8 were previously rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 2-4 and 6-8 were rejected by the Examiner on the basis that the Examiner contended that the addition of the term "only" to the original claim added new matter to the application. In light of applicant's arguments submitted 4/6/2001, the rejection is lifted.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1743

4. Claims 4 and 6-8 were previously rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is also lifted in response to applicant's arguments and clarification as to the dimensions described by applicant in reference to a user's thumb.

Inventorship

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1743

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 2-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scaramella et al. Claims 2-8 were rejected in previous actions, claim 9 is rejected under the same reasoning/grounds as claims 2-8. See Response to Arguments below.

Response to Arguments

9. Applicant's arguments filed 4/6/2001 have been fully considered but they are not persuasive. Applicant has argued that the invention as claimed is allowable over the reference "Scaramella" because the instant application is analogous to In re Edge since the omission of an element (the latching mechanism) while retaining its function is not obvious.

The Examiner respectfully disagrees and believes that this analogy is incorrect. That is, the element (latching mechanism) has been eliminated, but the function of the element *has not been retained in the device itself*. Instead, the function of that element is now being provided by *the hand (thumb and fingers) of the user* - which is clearly NOT part of the device.

Art Unit: 1743

Applicant has argued the following on page 12 of submitted arguments in comparing Scaramella to the instant invention:

(1) The function of Scaramella's latching mechanism is to maintain the holder card and transfer plate in a substantially fixed rotation with respect to one another.....Indeed if such functions were not present, the pipette tips would be subject to falling out of alignment.

While the Examiner agrees that this is **part** of the function of the latching mechanism, the Examiner would also like to point out that the latching mechanism of Scaramella is also used to *lift the holder card out of the pipette holder tray* without the need for the user touching the holder card itself! (See Scaramella, col. 3, lines 62-col. 4, lines 1-15) The latching mechanism of the transfer member "grabs" the alignment plate (Figure 5).

(2) Applicant has argued that the instant application employs a system that maintains the transfer member and the receiving plate in a substantially fixed orientation *by the thumb and fingers of the user*.

First, the Examiner would like to point out that the device itself retains none of the lifting function of the transfer member. In describing use of the device in the specification (p. 10) applicant clearly states that the user lifts **both the transfer member and receiving plate** from the container using his fingers! This clearly is a **function of the user - not the device**. Scaramella's device - with the latching mechanism - requires no such action. The user merely lifts the transfer member which is latched to the alignment plate.

Art Unit: 1743

In addition, the Examiner also contends that the function of the latching mechanism detailed by applicant in arguments is not retained in applicant's device either. Applicant has freely admitted in the specification and arguments (p. 12 of arguments again) that the transfer member and receiving plate are maintained in a substantially fixed orientation *by the thumb and fingers of the user*. These elements are clearly not part of the device. As such, **the device itself does not retain** even the "fixed orientation" function. This is also provided the user.

Thus the Examiner still contends that the claims are not analogous to In re Edge, but analogous to the situation described by Examiner previously: an omission of an element with a corresponding omission of function is within the ordinary skill in the art. As such, claims 2-9 are rejected.

Conclusion


10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 1743

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K. Handy whose telephone number is (703)-305-0211.


Jill Warden
Supervisory Patent Examiner
Technology Center 1700

dkh

June 18, 2001